

REMARKS

In the Office Action dated March 18, 2010, the Examiner acknowledged the filing of the Request for Continued Examination (RCE) and a Terminal Disclaimer on January 29, 2010, and acknowledged that claims 1-7, 15-19 and 22 were pending in the application. Claims 17-19 and 22, drawn to methods of treatment, were withdrawn from consideration. Claims 1-3 and 6-7 were rejected. Claims 4-5 were objected to for depending upon a rejected base claim(s), but would be allowable if rewritten as independent claims. Claims 15-16 were allowed.

A telephone interview was conducted on May 6, 2010 between the undersigned and the Examiner. During the interview, the Examiner confirmed that SEQ ID NOS: 7 and 8, which were reintroduced into claim 4 in the §1.114 Amendment (with RCE) filed on January 29, 2010, were considered. In response to the Examiner's request in the Office Action for information in support of the method claims, the undersigned attorney indicated that such information was submitted in the Response filed under §1.116 on October 30, 2009, but agreed to summarize the information in the instant Response.

The only outstanding rejection in the present Office Action is the non-statutory double patenting rejection of claims 1-3 (and dependent claims 6-7) based on U.S. Patent 7,507,717. The previously submitted Terminal Disclaimer has been disapproved because of certain wordings in the Terminal Disclaimer, allegedly not in compliance with 37 C.F.R. §1.321(c)(3).

Without agreeing to the Examiner's objection to the wordings, Applicants are providing herewith a new Terminal Disclaimer prepared in accordance with 37 C.F.R.

§1.321(c)(3). As such, the double patenting rejection based on U.S. Patent 7,507,717 is overcome, and withdrawal thereof is respectfully requested.

Applicants respectfully submit the following in response to the Examiner's remarks in the Action with respect to restriction and election.

On page 4 of the Office Action, the Examiner apparently has repeated the remarks in a prior Office Action, stating that additional peptides have been rejoined in the examination, i.e., SEQ ID NOS: 5-6, 9-11 and the genus peptide formula of claim 1, in addition to elected SEQ ID NO: 4.

As confirmed by the Examiner during the telephone interview on May 6, 2010, SEQ ID NOS: 7-8 have been included in the examination. Applicants respectfully request that the Examiner update his remarks with respect to peptides included in the examination (i.e., SEQ ID NOS: 4-11 and the genus peptide formula of claim 1) in the next Office Action.

On page 4 of the Action, the Examiner also acknowledged that the method claims will be rejoined once the product claims are found allowable. On page 7 of the Action, the Examiner has asked Applicants to supply the Office with support found in the specification or literature that the peptides as claimed (including the native and modified peptides bearing a core structure) are known or have been shown to treat the diseases, as claimed.

Applicants respectfully submit that all of the product claims, i.e., claims 1-7 and 15-16, are now in condition for allowance. In respect to supporting information for the method claims (claims 17-19 and 22), Applicants respectfully direct the Examiner's attention to Applicants' submission under §1.116 on October 30, 2009. It is noted that Applicants requested entry of this §1.116 submission into the record through filing of the RCE on January 29, 2010.

Specifically, in the §1.116 Response filed on October 30, 2009, Applicants identified support in the specification and literature showing that Xen2174 (the amino acid of which is set forth in SEQ ID NO: 4) is effective in treating pain, e.g., neuropathic pain, post-surgical pain and cancer pain. Applicants also identified therein supporting information showing that other NET inhibitors (including antidepressants), which act on NET (same target as χ -conotoxin peptides) in the treatment and control of pain, including cancer pain, migraine, neuropathic pain and phantom limb pain, for example. Therefore, Applicants respectfully submit that as supported by the specification and available literature, those skilled in the art are fully enabled to practice the claimed methods, without undue experimentation. As indicated during the telephonic communication with the Examiner on May 6, 2010, resubmission of copies of the supporting exhibits provided with the Response filed on October 30, 2009 is not necessary.

In view of the foregoing amendments and remarks, it is firmly believed that the present application is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,



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